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M. P.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/295,856 04/21/99 COLLART

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EXAMINER

RODRIGUEZ, P

ART UNIT

PAPER NUMBER

2786

DATE MAILED: 03/23/00

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/295,856

Applicant(s)

COLLART, TODD R.

Examiner

Paul L Rodriguez

Art Unit

2786

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
 2. ☐ received in Application No. (Series Code / Serial Number) ____.
 3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

Art Unit: 2786

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference number 530, referred to on page 34 line 5 in the specification. Correction is required.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the package tracking identifier incorporated on the package, the package in which the electronic medium is stored, and coupling the package with the computer must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Art Unit: 2786

5. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

Specification

6. The disclosure is objected to because of the following informalities:

In the Abstract, line 21, after the word “information” and before the next word “and” there is a “.” and a “,” next to each other.

Page 1 line 4, the author/applicant’s name is listed as a by line, this should be removed.

Page 6 line 23, the acronym BCA is used in the summary of the invention, however the definition of BCA is not provided until page 10.

Page 6 line 29, after the word “information” and before the next word “and” there is a “.” and a “,” next to each other.

Page 8 line 1, states “Figure 8 presents logic demonstrating the display of specific...” Examiner recognizes figure 8 as a flowchart (same as figures 6, 7 and 9-23) without decision boxes or logic.

Page 10 line 24, refers to package 22. The number 22 was previously used to identify the storage medium. The storage medium 22 is found in figure 1 but the package is not depicted.

Page 26 lines 8 and 9, make reference to “Unlock Server 230”. In figure 2, reference number 230 is located next to the “RemoteTrak Server”. Unable to determine if the Unlock Server and the RemoteTrak Server are the same.

Art Unit: 2786

Page 25 line 4, the acronym POP/MDF is used, however this acronym is not defined until page 26 line 25.

Page 26 line 18, refers to the "RemoteTrak Server function block 230". The number 230 was previously used (Page 26 line 8) to identify the "Unlock Server".

Page 32 line 10, refers to "function block 234 RemoteTrak/BCA Trak Server". In figure 2, reference number 234 is used to identify "BCA Trak PlugIn" and reference number 230 is used to identify "RemoteTrak server". There is no "function block 234" in the figure which contains both the RemoteTrak and the BCA Trak server.

Page 32 line 25, refers to "function block 238 DVDUnlock Server". In figure 2, reference number 238 is used to identify the RemoteSync Server. Examiner is unable to locate the "DVDUnlock Server" in the figures provided.

Page 32 line 29 and Page 33 line 1, refers to "function block 230 RemoteTrak/BCA Trak Server". The RemoteTrak/BCA Trak Server was previously identified with number 234. Reference number 230 was previously used to identify the "RemoteTrak Server function block" (page 26 line 18) and reference number 230 was also previously used to identify the "Unlock Server" (page 26 line 8).

Page 33 line 11, refers to "function block 238 DVD Unlock Server, Remote Sync". The "Unlock Server" was previously identified with number 230 (page 26 line 8) and "RemoteSync" was previously identified as 238 (page 26 line 7 and in figure 2).

Page 33 line 13, refers to "function block 238 RemoteTrak/BCA Trak Server". The "RemoteTrak/BCA Trak Server" was previously identified with number 234. Reference number

Art Unit: 2786

238 was previously used to identify "DVD Unlock Server, Remote Sync", while figure 2 identifies number 238 as the "RemoteSync Server" only.

Page 33 line 22, refers to "ISAPI Extension 520" however, figure 5 uses the number 540 to identify the ISAPI Extension.

Page 33 lines 27-28 and page 34 line 29, use hyperlink text which is not allowed in the specification. The embedded hyperlinks and/or other forms of browser-executable code are impermissible and require deletion. The attempt to incorporate subject matter into the patent application by reference to a hyperlink and/or other forms of browser-executable code is considered to be an improper incorporation by reference.

Page 37 line 24 and page 38 line 10, uses the word "informatio", the word should be information.

Page 56 line 10 refers to table 1. Data provided on this page is not in table format and the table could not be identified.

Many sections in the specifications are considered irrelevant and excessive in the reference to the claimed invention. Page 14 line 1 through page 21 line 4 go into great detail on the topic of object-oriented programming, which is well known in the art. Page 26 line 29 through page 32 line 5 deals with coupon distribution and are not related to the claimed invention. It is requested that the applicant review the specification and remove any text not relating to the claimed invention.

Appropriate correction is required.

Art Unit: 2786

7. The extensive use of the trademarks has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Applicant is reminded to properly acknowledge all uses of trademarks.

Claim Rejections - 35 USC § 112

8. Claims 6-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 6 recites the limitation "the tracking information" in line (d). There is insufficient antecedent basis for this limitation in the claim.

10. Claim 11 recites the limitation "the tracking information" in line (b). There is insufficient antecedent basis for this limitation in the claim.

11. Claim 11 recites the limitation "the package" in line (b). There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2786

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 4, 6, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (U.S. Pat. 5,860,068) in view of Fuchigami et al (U.S. Pat. 5,960,398).

Cook provides a disclosure of a method and system for selling and distributing digital data products from retail stores over the Internet, telephone lines and other electronic means. The Cook reference teaches a method for tracking the distribution of content electronically (Col. 10 lines 49-55). Cook teaches incorporation of a tracking identifier on the package containing the electronic medium (Col. 10 lines 23-38). Cook teaches storing the tracking identifiers in a database, and detecting the tracking information when coupled with a computer (Col. 10 lines 38-41). Cook teaches transmitting the tracking information to a server computer (Col. 10 lines 45-55). Cook teaches determining appropriate updated information from the server (Col. 10 lines 48-55). Cook teaches a server computer performing a lookup to determine the retailer (Col. 6 lines 25-44). Cook teaches a server computer transmitting an information banner to the computer (Col. 6 lines 51-60).

Cook fails to teach the incorporation of an electronic storage medium tracking identifier on the electronic storage medium, an optical disc having a burst cut area, a digital code stored in the burst cut area, and a digital code representative of an identifier of content on the optical disc storage medium.

Fuchigami et al teaches incorporation of an electronic storage medium tracking identifier on the electronic storage medium (Col. 5 lines 45-56). Fuchigami et al teaches, an optical disc

Art Unit: 2786

having a burst cut area, a digital code stored in the burst cut area, and a digital code representative of an identifier of content on the optical disc storage medium (Col. 5 lines 45-65).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the copyright information embedding apparatus of Fuchigami et al into the method and system for selling and distributing digital data products from retail stores over the Internet, telephone lines and other electronic means of Cook because Fuchigami et al provides a system that provides copyright protection of data on optical disc without the degradation of the information contained on the disk and unauthorized copies of the data can be easily identified. Also, the digital data embedded in the burst cut area on the disc can have many different identifiers, such as a cutting player identification code, a source identification code, a recording date, a number of recordings, number of copies, or any other information desired.

14. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (U.S. Pat. 5,860,068) in view of Fuchigami et al (U.S. Pat. 5,960,398) as applied to claims 1, 2, 4, 6, 7 and 9 above, and further in view of Coddington et al (U.S. Pat. 5,410,343).

Cook as modified by Fuchigami et al teaches a method and system for selling and distributing digital data products in an optical disc format, where information about the optical disc is embedded on the disc using a burst cut area, and shipping information is tracked over the Internet as recited in claims 1, 2, 4, 6, 7 and 9 for the reasons above, differing from the invention as recited in claims 3 and 8 in that their combined teaching lacks the server computer performing a table lookup to determine one or more authorized titles.

Art Unit: 2786

Coddington et al teaches video on demand services connected over telephone services. Coddington et al teaches a server computer performing a table lookup to determine one or more authorized titles (Col. 9 lines 20-38).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the server table lookup to determine the authorized titles of Coddington et al in the method and system for selling and distributing digital data products of Cook as modified by Fuchigami et al to include a server that has access to the titles that are available to the consumer, because Coddington et al teaches that having an access list of authorized titles for each consumer or subscriber can protect the consumer from accessing undesirable programming (Col. 3 lines 17-22). This way children without proper ID verification are restricted from viewing certain programs that may be inappropriate.

15. Claims 5, 10-12, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (U.S. Pat. 5,860,068) in view of Fuchigami et al (U.S. Pat. 5,960,398) as applied to claims 1, 2, 4, 6, 7 and 9 above, and further in view of Ginter et al (U.S. Pat. 5,892,900).

Cook as modified by Fuchigami et al teaches a method and system for selling and distributing digital data products in an optical disc format, where information about the optical disc is embedded on the disc using a burst cut area, and shipping information is tracked over the Internet as recited in claims 1, 2, 4, 6, 7 and 9 for the reasons above, differing from the invention as recited in claims 5, 10-12, and 14-17 in that their combined teaching lacks transaction data written to a database memorializing processing, a program embodied on a computer readable medium for identifying and providing a response to the use of an electronic storage medium

Art Unit: 2786

having an identifier incorporated thereon, the code segment that receives live update information from the server computer, and a code segment that reads the identifier of the electronic storage medium upon being input into a computer by a user.

Ginter et al teaches a system and method for secure transaction management and electronic rights protection. Ginter et al teaches transaction data written to a database memorializing processing (Col. 24 lines 24-53). Ginter et al teaches a program embodied on a computer readable medium for identifying and providing a response to the use of an electronic storage medium having an identifier incorporated thereon (Col. 235 line 28 – Col. 237 line 54). Ginter et al teaches the server computer receiving live update information (Col. 90 lines 42-50). Ginter et al teaches a code segment that reads the identifier of the electronic storage medium upon being input into a computer by a user (Col. 235 line 28 – Col. 237 line 54).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a system and method for secure transaction management and electronic rights protection of Ginter et al in the method and system for selling and distributing digital data products of Cook as modified by Fuchigami et al to include a distributed system software for users of the e-commerce systems because the Virtual Distribution Environment of Ginter et al provides protection of electronic rights for authors of electronic content, commercial rights, rights of parties who facilitated the distribution of content and privacy rights for parties portrayed by distributed content (Col. 5 lines 29-39).

16. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (U.S. Pat. 5,860,068) in view of Fuchigami et al (U.S. Pat. 5,960,398) in view of Ginter et al (U.S. Pat.

Art Unit: 2786

5,892,900) as applied to claims 5, 10-12 and 14-17 above, and further in view of Coddington et al (U.S. Pat. 5,410,343).

Cook as modified by Fuchigami et al and Ginter et al teaches a method and system for selling and distributing digital data products in an optical disc format, where operating software is distributed to the consumers, where information about the optical disc is embedded on the disc using a burst cut area, and shipping information is tracked over the Internet as recited in claims 5, 10-12 and 14-17 for the reasons above, differing from the invention as recited in claim 13 in that their combined teaching lacks the server computer performing a table lookup to determine one or more authorized titles.

Coddington et al teaches video on demand services connected over telephone services. Coddington et al teaches a server computer performing a table lookup to determine one or more authorized titles (Col. 9 lines 20-38).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the server table lookup to determine the authorized titles of Coddington et al in the method and system for selling and distributing digital data products in an optical disc format of Cook as modified by Fuchigami et al and Ginter et al to include a server that has access to the titles that are available to the consumer because Coddington et al teaches that having an access list of authorized titles for each consumer or subscriber can protect the consumer from accessing undesirable programming (Col. 3 lines 17-22). This way children without proper ID verification are restricted from viewing certain programs that may be inappropriate.

Art Unit: 2786

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Krishna et al (U.S. Pat. 6,012,071) – A publishing system for distribution over the Internet.

LeMole et al (U.S. Pat. 6,009,410) – Method and system for presenting advertising to users on the Internet.

Griswold (U.S. Pat. 5,940,504) – A management system controlled by a server at the site that controls the license of the electronic product.

Wilf et al (U.S. Pat. 5,899,980) – Provides a retail method for a wide area network that utilizes secure servers for the transaction.

Article from the ProDivx Website – Provides a brief description of DIVX, an optical disc movie system in which a consumer establishes an access and billing account with a central server, the DIVX player is connected via phone lines and modem, to a server for access, authorization and program information.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (703) 305-7399.

The examiner can normally be reached on 6:30 - 4:00 M-Th and alternate F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Grant can be reached on (703) 308-1108. The fax phone numbers for the


Art Unit: 2786

organization where this application or proceeding is assigned are (703) 305-3718 for regular communications and (703) 305-3718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Paul L Rodriguez
Examiner
Art Unit 2786

March 16, 2000


WILLIAM GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700
3/17/00